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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,460	06/05/2001	Dan Kikinis	ISURFTV136	6281
52940	7590	10/06/2005	EXAMINER	
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/875,460

Applicant(s)

KIKINIS, DAN

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

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### *Response to Arguments*

1. Applicant's arguments with respect to all amended claims have been considered but are moot in view of the new ground(s) of rejection. Accordingly, **THIS ACTION IS MADE FINAL.**

2. Applicant's amendments, dated 9/905, have been entered and made of record.

3. Due to Applicant's amended Drawings, the objection applied in the previous Non-Final action is hereby withdrawn.

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 6, 9-12, 14, 17-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US Pat. Pub No. 2005/0028208).

As to Claim 1, Ellis et al disclose an interactive television system wherein a remote access terminal is used to perform a variety of functions, including the storage and transmission of EPG selections. (Abstract; Pars. [0014-0016]). Accordingly, Ellis et al anticipate each and every limitation of Claim 1.

Claims 9 and 17 correspond to the method claim 1. Therefore, each is analyzed and rejected as previously discussed.

As to Claims 2 and 3, Ellis further discloses storing EPG selections on a broadcast server and set top box, respectively. (Par. [0017] & Fig. 3). Accordingly, Ellis et al anticipate each and every limitation of Claims 2 and 3.

Claims 10 and 18 correspond to Claim 2, while Claims 11 and 19 correspond to Claim 3. Thus, each is analyzed and rejected as previously discussed.

As to Claim 4, Ellis further discloses the remote terminal can be a PDA. (Par. [0092]). Accordingly, Ellis et al anticipate each and every limitation of Claim 4.

Claims 12 and 20 correspond to the method claim 4. Therefore, each is analyzed and rejected as previously discussed.

As to Claim 6, Ellis further teaches the system displays EPG selections on the remote terminal when requested. (Par. [0015]). Accordingly, Ellis et al anticipate each and every limitation of Claim 6.

Claims 14 and 22 correspond to the method claim 6. Therefore, each is analyzed and rejected as previously discussed.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 5, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al in view of Elliot. (US Pat. No. 6,473,097).

Applicant's claim 5 recites the method of claim 1, further including receiving EPG selections entered via a separate wireless web phone. (Note: the Examiner interprets "wireless web phone" to mean any wireless phone having Internet access.) As discussed above, Ellis et al anticipate each and every limitation of claim 1, but fail to specifically teach the limitations of claim 5. However, within the same field of endeavor, Elliot discloses a cellular phone which can receive/transmit data over the Internet via radio frequencies. (Col. 3, Ln. 36-46 & Col. 4, Ln. 36-46). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Ellis and Elliot in order to provide a system capable of requesting EPG data via a mobile phone, thereby providing the user with an apparatus which allows him or her to reserve programs from remote locations.

Claims 13 and 21 correspond to the method claim 5. Thus, each is analyzed and rejected as previously discussed.

*[Note: Applicant argues that Elliot is a non-analogous art. (Applicant's Response, Pg. 10). However, the Examiner disagrees. For the sake of clarification, Elliot was applied to show that web enabled phones were well known in this art at the time of Applicant's invention. To further strengthen this argument and to provide more evidence as to the state of the art at the time of Applicant's invention, the Examiner cites Christopoulos et al, US Pat. Pub. No. 2001/0047517, which disclose a web enable phone capable of receiving audiovisual data. (Par. [0003-0005]). Accordingly, the use of web-enabled phones was notoriously well known in this art at the time of Applicant's invention. Thus, the application of the Elliot reference was proper.]*

6. Claims 7, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al.

Applicant's claim 7 recites the method of claim 6, further including transmitting the EPG selections to multiple separate devices to be displayed concurrently on the devices when requested. As discussed above, Ellis anticipates each every limitation of claim 6, and further contain all limitations of claim 7 as well. In light of the combined disclosures used to reject claim 6, claim 7 would be an obvious variant. Transmitting EPG data to multiple remote terminals is obvious in light of a disclosure already teaching transmittal to one remote terminal. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to modify the teaching of Ellis in order to provide multiple separate devices, thereby allowing multiple users to utilize the system concurrently.

Claims 15 and 23 correspond to the method claim 7. Accordingly, each is analyzed and rejected as previously discussed.

7. Claims 8, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al in view of Terakado et al. (US Pat. No. 6,246,441).

Applicant's claim 8 recites the method of claim 6, further including transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections. As discussed above, Ellis et al anticipate each and every limitation of claim 6, But fails to specifically recite the limitations of Claim 8. However, within the same field of endeavor, Terakado et al disclose a similar system which is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal. (Col. 9, Ln. 47-53). Therefore, it would have been obvious to one of ordinary skill in this art at

the time of applicant's invention to further combine the systems of Ellis and Terakado in order to provide for a system capable of allowing the user to view broadcast programs simultaneously while viewing EPG data, thus allowing other persons to continue viewing the broadcast without being disturb by the one viewer who desires to search the EPG data.

Claims 16 and 24 correspond to the method claim 8. Therefore, each is analyzed and rejected as previously discussed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye  
September 26, 2005.

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', with a long horizontal flourish extending to the right.

VIVEK SRIVASTAVA  
PRIMARY EXAMINER